

SHERWOOD 48 ASSOCS. v. SONY CORP. OF AMERICA*76 Fed. Appx. 389 (2d Cir. 2003)*

The Second Circuit held that the owners of three Times Square buildings who brought suit against the producers of the motion picture *Spider-Man*, for depicting digitally altered billboard advertisements upon the owners' buildings in the movie, failed to identify with enough precision their protectable trade dress under the Lanham Act, 15 U.S.C. § 1125(a).

Spider-Man includes a scene set in New York City's Times Square during a fictional "World Unity Festival." Producer Sony made agreements with various companies to superimpose their advertising on the buildings as they appear in the recreated version of Times Square. The building owners alleged violation of § 43(a) of the Lanham Act, which provides a private cause of action against any person who, "in connection with any goods . . . or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, which . . . is likely to cause confusion, or to cause mistake, or to deceive . . . as to the origin, sponsorship, or approval of his or her goods . . . by another person" 15 U.S.C. § 1125(a).

The Second Circuit held that the building owners did not identify their purportedly protectable trade dress with the requisite precision in their complaint. The court stated that by seeking protection of both "the configuration" of the three buildings and the advertising and signage display on the faces of the buildings, the plaintiffs plainly sought to protect the "overall look" of each of the buildings, and yet they failed to identify the specific elements that comprise each building's identifiable dress. Concluding that this "basic defect" in the pleading could not be cured, the court affirmed the district court's dismissal of the claim.

The plaintiffs also alleged four tort claims under New York law: unfair competition, deceptive trade practices, dilution, and trespass. The Second Circuit held that the district court erred in asserting supplemental jurisdiction over these claims because they involved unsettled questions of state law—specifically, whether a trespass is committed under New York law when a party's physical contact with another party's personal property diminishes the value of that property even if it does no damage. Noting that the California Supreme Court had recently concluded that "the tort [of trespass to chattels] does not encompass, and should not be extended to encompass, an electronic communication that neither damages the recipient computer system nor impairs its functioning," *Intel Corp. v. Hamidi*, 71 P.3d 296 (Cal. 2003), the Second Circuit concluded that a New York court should determine in this case whether physical damage to the buildings is a prerequisite to a trespass claim. The court also determined that a New York court should likewise decide upon the plaintiffs' other state claims, and accordingly vacated their dismissal by the district court.

